REMARKS

Before this Amendment, claims 35-39 are pending. By this Amendment, new claims 70-72 have been added. Therefore, claims 35-39 and 70-72 are now pending.

Support for new claims 70-72 is found in the specification as filed, at page 4, lines 21-23.

Claim 35 has been amended to recite that "the free base is present in an amount sufficient for a dosing unit." Support for this amendment is found in the specification as filed, at page 16, lines 20-23. The Applicants note that "dosing unit" is defined in the specification at page 16, lines 16-23, as follows: "In this patent application, the expression 'dosing unit' is understood to mean a pharmaceutical formulation that contains a defined amount of active ingredient and that releases this following the one-time administration in patients over a predetermined period of time in a therapeutically effective amount." Thus, no issues of indefiniteness should be raised by recitation of "dosing unit" in amended claim 35.

The specification has been amended to add a Brief Description of the Drawings section. Support for the brief description of Figure 1 is found in the specification, at page 42, line 27. Support for the brief description of Figure 2 is found in the specification, at page 32, lines 4-6. Support for the brief description of Figure 3 is found in the specification, at page 32, lines 4-6. Support for the brief description of Figure 4 is found in the specification, at page 14, lines 33-34.

Objections to the Drawings and Specification

The Office Action objected to the drawings because "Figure numbers and Brief description of the drawings is lacking from specification" (Office Action, page 2).

The Office Action objected to the specification because "'Brief Description of the Drawings' is Lacking" (Office Action, page 3).

The specification has been amended to include a Brief Description of the Drawings section. No new matter has been added by this amendment.

Accordingly, it is respectfully requested that these objections be withdrawn.

The rejection under 35 U.S.C. §102(b)

Claims 35-39 were rejected as being anticipated by WO 99/58478 (Meese).

The Applicants respectfully request reconsideration and withdrawal of this rejection. The Office Action stated that the disclosure of Meese at page 11, lines 13-14, anticipates the present claims. See the Office Action, page 4:

> Meese et al disclose R-(+)-isobutyric acid 2-(3-diisopropylamino-1-phenylpropyl)-4-hydroxymethylphenyl ester (page 11, lines 13-14), (the compound of the instant claim 39) . The above compound is disclosed as a free base of R configuration.

Page 11, lines 13-14, of Meese discloses the following chemical name and nothing else:

R-(+)-isobutyric acid 2-(3-diisopropylamino-1-phenyl-propyl)-4-hydroxymethylphenyl ester,

In particular, this portion of Meese makes no mention of salt content, degree of purity, or amount.

The presently amended claims all require a salt content of "less than 10% by weight," a degree of purity of "above 97% by weight," and "an amount [of free base] sufficient for a dosing unit." Meese provides no disclosure of R-(+)-isobutyric acid 2-(3-diisopropylamino-1-phenylpropyl)-4-hydroxymethylphenyl ester having this salt content, degree of purity, or amount. Meese provides the name of a compound and nothing more.

Even if, for the sake or argument, the disclosure at page 11, lines 13-14, of Meese is viewed as disclosing the salt content, degree of purity, and amount of the free base recited in the present claims, Meese would not anticipate the present claims because Meese discloses no method of how to actually obtain the recited salt content, degree of purity, and amount and the Office Action does not point to where in the prior art the knowledge of how to obtain such levels of salt content, purity, and amount is found.

Meese discloses a general process for making phenolic monoesters on page 59, line 22, to page 60, line 12. The process involves reacting a carboxylic acid monochloride with (±)-2-(3-diisopropylamino-1-phenylpropyl)-4-hydroxymethylphenol in dichloromethane and then adding triethylamine. When this process was carried out with isobutyric acid chloride as the carboxylic acid monochloride and R-(+)-2-(3-diisopropylamino-1-phenylpropyl)-4-hydroxymethylphenol, the resulting R-(+)-isobutyric acid 2-(3-diisopropylamino-1-phenylpropyl)-4-hydroxymethylphenyl ester was found to have a degree of purity of only 94.1% (see the present

application, page 42, line 25, to page 43, line 8). Furthermore, typically this process gave degrees of purity that were even lower (i.e., 90.5%-94.4%; see page 43, lines 6-7).

The present application states, at page 2, line 29, to page 3, line 13:

> The bases of 3,3-diphenylpropylamines published in WO 99/58478 are manufactured by 2-(3-diisopropylamino-1-phenylpropyl)-4-hydroxymethylphenol being converted under alkaline conditions with an appropriate acid chloride, for example, isobutyric acid chloride (see Example Execution 3aa of WO 99/58478).
>
> This reaction, however, only leads disadvantageously to approximately 90% up to a maximum approximate 94% of the desired main product (B). The product consistently contains 6-10% impurities of the starting substance (A), the used acylation agent as well as undesired reaction products in the form of the corresponding di-ester of the acylating reagent used (C) of the monoester (D) of the 4-hydroxy group (see FIG. 1) as well as by dimerization/polymerization.
>
> Attempts by the inventor of this patent application to make the synthesis reaction more selective by, for example, varying the amount of the acylating reagent and/or the acylating conditions (temperature, solvent, concentrations, sequence of the addition, among other things), did not lead to the desired result.
>
> Even extensive trials to purify the high purity base from the product mix in the amounts required for pharmaceutical purposes using conventional procedures remained unsuccessful.

Thus, the evidence of record indicates that Meese does not enable the production of a compound having the level of salt content and degree of purity recited in the present claims and in sufficient amounts required for pharmaceutical purposes.

Since what is being claimed in the present application is not merely a compound having the name disclosed at page 11, lines 13-14, of Meese but instead is that compound having a specified salt content and degree of purity, in an amount sufficient for a dosing unit. Meese cannot anticipate such a claimed compound unless Meese enables the production of such a

compound. Case law holds that a putatively anticipating prior art reference must do more than merely name a compound; it must enable the claimed invention by placing the public in possession of the invention. Merely naming a claimed compound is not enough.

See, e.g., *Elan Pharmaceuticals, Inc. v. Mayo Foundation*, 346 F. 3d 1051, 1055, 68 U.S.P.Q. 2d 1373, 1376 (Fed. Cir. 2003): "The disclosure in an assertedly anticipating reference must be adequate to enable possession of the desired subject matter. It is insufficient to name or describe the desired subject matter, if it cannot be produced without undue experimentation."

See also *Ex parte Wall*, 156 U.S.P.Q. 95 (Bd. App. 1964), where the Board considered an examiner's rejection under 35 U.S.C. §102 of a claim reading "Perfluorostyrene." In reversing the examiner, the Board commented that the examiner did not contend that the reference disclosed how perfluorostyrene is made, nor did he point to any extraneous evidence which would indicate that those skilled in the art knew how to make that compound. As a result, the rejection under 35 U.S.C. §102 could not stand. The Board stated, at 156 U.S.P.Q. 96:

> The stated position of the examiner is that the naming of the compound of appealed claim 1 in the Dittman et al. reference, published more than a year prior to the filing of the instant case, is sufficient to defeat the appealed claim.
>
> …
>
> Appellants contend that the description of the compound of the appealed claim in the Dittman et al. patent is not sufficient to satisfy the term "described" as that term is used in 35 U.S.C. 102(b). It is the expressed view of appellants that the mere mention of perfluorostyrene in the patent, without a disclosure of how to make the compound, is not sufficient to put the public in possession of the claimed invention and accordingly the reference cannot defeat the appealed claim.
>
> …
>
> After careful consideration of the facts of the present application in the light of the case law, we are of the opinion that the mere mention of perfluorostyrene in the

> Dittman patent, without more, is insufficient disclosure to put the public in possession of the invention defined by the appealed claim, and that the invention is accordingly not "described in a printed publication" as that clause of 35 U.S.C. 102(b) is interpreted in the LeGrice decision. We accordingly will not sustain the rejection of appealed claim 1.

The Board in *Wall* also quoted approvingly from *Phillips Petroleum Co. v. Ladd*, 219 F. Supp. 366, 370, 138 U.S.P.Q. 421, 424 (D.D.C. 1963): "A mere naked formula for a chemical compound which teaches the art nothing about the product which it may represent, and does not put anyone in possession of the invention, is not the type of statement that should be relied upon for anticipation."

By failing to teach how to make the presently claimed compound, including its limitations with respect to salt content, purity, and amount, Meese does not place the presently claimed compound in the possession of the public, does not enable the presently claimed invention, and thus cannot support an anticipation rejection.

A finding that Meese does not anticipate the present claims is in keeping with the line of cases that hold that the disclosure of an impure compound does not anticipate claims to a pure compound. See, e.g., *In re Bergstrom,* 427 F. 2d 1394, 166 U.S.P.Q. 256 (C.C.P.A. 1970), where the court framed the dispositive issue as "whether the *claimed* pure materials are *novel* as compared with the *less pure* materials of the reference." (427 F. 2d at 1401-1402, 166 U.S.P.Q. at 262) The court then stated: "It seems to us that the answer to that question is self-evident: by definition, pure materials necessarily differ from *less* pure or impure materials and, if the latter are the only ones existing and available as a standard of reference, as seems to be the situation

here, perforce the 'pure' materials are 'new' with respect to them." (427 F. 2d at 1401-1402, 166 U.S.P.Q. at 262)

In view of the above, it is respectfully requested that this rejection be withdrawn.

The Applicants hereby make a Conditional Petition for any relief available to correct any defect seen in connection with the filing of this paper, or any defect seen to be remaining in this application after the filing of this paper. The Commissioner is authorized to charge Kenyon & Kenyon's Deposit Account No. 11-0600 for the Petition fee and any other fees required to effect this Conditional Petition.

Respectfully Submitted,

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